

Attorney Docket No.: ISPH-0569
Inventors: Anderson et al.
Serial No.: 09/853,409
Filing Date: May 11, 2001
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REMARKS

Claims 23-27 are pending in the instant application. Claims 23-27 have been rejected. Claim 27 has been canceled. Claims 23, 24, 25 and 26 have been amended. New claims 28-31 have been added. No new matter has been added through these new claims. Reconsideration is respectfully requested in light of these additions and amendments and the following remarks.

I. Rejection of Claims Under 35 U.S.C. 102(b)

Claim 23 has been rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (1986) or Storey et al. (1991). The Examiner suggests that these papers each teach an antisense oligonucleotide that contains a region complementary to a portion of the HCV genome and its use in a pharmaceutically acceptable carrier that, without evidence to the contrary, would be suitable for subcutaneous administration. Applicants respectfully traverse this rejection.

Applicants have amended claim 23 to recite that the composition of the instant invention comprises SEQ ID NO: 6. Support for these amendments to the claims can be found throughout the specification as filed but in particular at pages 31-44.

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The Examiner has suggested the reply filed on January 21, 2004 was not fully responsive to the prior Office Action because a Terminal Disclaimer was not filed to overcome the obviousness type double patenting rejection over U.S. Patent 6,423,489. Applicants respectfully point out that a Terminal Disclaimer for U.S. Patent 6,423,489 was filed via facsimile with the response to the Office Action on January 21, 2004. Applicants are resubmitting the complete response accompanied by a copy of the Auto-Reply Facsimile Transmission sheet received from the U.S. Patent and Trademark Office.

Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

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Smith et al. (1986) disclose an antisense oligonucleotide that is complementary to a region of the HCV genome. Nowhere does this paper teach or suggest a composition that comprises SEQ ID NO: 6. Storey et al. (1991) discloses an antisense oligonucleotide that is complementary to a portion of the HCV genome, however, nowhere does this paper teach or suggest a composition comprising SEQ ID NO: 6. MPEP 2131 states that in order to anticipate an invention the cited reference must teach each and every limitation of the claims. Accordingly, these references cannot anticipate the invention of the amended claims as they fail to teach the limitations of those claims. Withdrawal of this rejection is respectfully requested.

II. Double Patenting

Claims 23-27 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent 6,608,191 and claims 1 and 7 of U.S. Patent 6,423,489. Applicants have filed herewith a terminal disclaimer in compliance with 37 CFR 1.321(c). Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims Under 35 U.S.C. 112, Second Paragraph

Claims 23-27 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for particularly point out and

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distinctly claim the subject matter which applicants regard as the invention. The Examiner suggests that the language is unclear in reciting the phrase "in a form suitable for subcutaneous administration" with regard to whether it relates to the oligonucleotide or to the composition. Applicants have amended the claims to make it clear that the composition is administered subcutaneously. Withdrawal of this rejection is respectfully requested.

IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

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